

PATENT**Application # 10/035,306****Attorney Docket # 2000-0534 (1014-164)****REMARKS**

The Examiner is respectfully thanked for the thoughtful consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1, 3, 8, and 9 has been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-14 are now pending in this application. Each of claims 1 and 8 are in independent form.

The Anticipation Rejections

Each of claims 1, 4-8, and 10-14 was rejected as anticipated under 35 U.S.C. 102(b). In support of the rejection, Faigon (U.S. Patent No. 6,006,016) was cited. These rejections are respectfully traversed.

Faigon fails to establish a *prima facie* case of anticipation. *See* MPEP 2131. To anticipate expressly, the "invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim". *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter "with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention". *Crown Operations Int'l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one

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with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marlon Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003) ("A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.") The USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

Specifically, claims 1 and 8, from one of which claims 2-7 and 9-14 depend recite "monitoring each network element that exhibits persistent performance degradation at successive third intervals that are shorter than the successive second intervals". As acknowledged in the Office Action, Faigon does not teach expressly or inherently "monitoring each network element that exhibits persistent performance degradation at successive third intervals that are shorter than the successive second intervals". Accordingly, it is respectfully submitted that the rejection of claims 1, 4-8, and 10-14 is unsupported by Faigon and should be withdrawn.

The Obviousness Rejections

Each of claims 2, 3, and 9 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of Faigon (U.S. Patent No. 6,006,016) in view of Cidon (U.S. Patent No. 6,269,330). These rejections are respectfully traversed.

None of the cited references, either alone or in any combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *See* MPEP 2143. Moreover, the USPTO "has the initial duty of supplying the

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factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

As described above, each of independent claims 1 and 8, and each claim depending therefrom recites “monitoring each network element that exhibits persistent performance degradation at successive third intervals that are shorter than the successive second intervals”. As acknowledged in the Office Action, Faigon does not expressly or inherently teach or suggest “monitoring each network element that exhibits persistent performance degradation at successive third intervals that are shorter than the successive second intervals”.

Cidon is allegedly directed to “sending commands to one or more traffic agents connected to the network and to at least one network management agent coupled to a respective node of the network, transmitting data from at least one of the traffic agents over the network responsive to the commands”. See Abstract.

Cidon’s “system further comprises a testing center which conducts tests of the network. The testing center controls the operations of the traffic agents and NM agents by sending them commands or groups of commands, referred to herein as subscripts. In response to the commands, the traffic agents and/or NM agents perform actions and generate reports relating to the network and the traffic therethrough and send the reports to the testing center. The testing center uses the reports from the agents to determine additional tests to be performed and/or to evaluate the state of the network and generate test results which are provided to an operator. Preferably, the testing center stores a plurality of pre-written sets of instructions, referred to herein as scripts, each of which is directed to conduct a specific test session.” See col. 2, lines 49-63.

On the other hand, Faigon describes the “shortcomings” of “prior art techniques” that “alert a centralized device”. Specifically, Faigon states that “sophisticated techniques for fault detection and diagnosis include receiving traps or other types of alert signals from devices within the network. As faults are detected, devices can alert a centralized device such as a computer system or other networking system management console, that such faults have occurred. These prior art techniques have suffered from some shortcomings, however. First,

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typical prior art fault detection and diagnostic systems include **centralized consoles** which **receive and record fault alert signals or traps as they occur.**" See col. 1, lines 30-48.

Moreover, Faigon states that "[o]ne of the objects of the present invention is to provide a network fault diagnostic system which **does not rely upon a single device** for detecting faults." See col. 2, lines 41-43. To fulfill this objective, Faigon states that the **"correlating of the occurrences of the fault events may be performed by a plurality of distributed network devices"** (col. 3, lines 7-8), and thereby **"the load of correlating faults is distributed"** (col. 3, line 15).

Faigon then states that "[t]hese and other objects of the present invention are provided for by a fault correlation apparatus for use in a networking system which includes a **plurality of fault correlators**" (col. 3, lines 44-47), each of which **"invokes a current rule base to evaluate new events in the system in relation to known events"** (col. 6, lines 63-65).

So, to "evaluate the state of the network", Cidon is directed toward a "center", while **Faigon rejects such "centralized" devices in favor of "distributed network devices"**.

If a proposed combination would render a reference inoperable for its intended purpose, the reference teaches away from the proposed combination. *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1994). "If references taken in combination would produce a 'seemingly inoperative device,' ... such references teach away from the combination and thus cannot serve as predicates for a *prima facie* case of obviousness". *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001).

Because the combination of Faigon with Cidon would render at least one of Faigon and Cidon "inoperable for its intended purpose" and/or change the principal of operation of at least one of Faigon and Cidon, "such references teach away from the combination and thus cannot serve as predicates for a *prima facie* case of obviousness".

Therefore, the cited combination of Faigon and Cidon fails to establish a *prima facie* case of obviousness. Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

PATENT**Application # 10/035,306****Attorney Docket # 2000-0534 (1014-164)****Allowable Subject Matter**

The following is a statement of reasons for the indication of allowable subject matter: "none of the references of record alone or in combination disclose or suggest the combination of limitations found in the pending claims. Namely, claims 1-14 are allowable because none of the references of record alone or in combination disclose or suggest "monitoring each network element that exhibits persistent performance degradation at successive third intervals that are shorter than the successive second intervals".

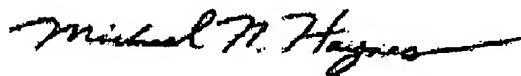
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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